

Hearing:
March 23, 2004

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
June 8, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Titan International, Inc.

Serial No. 75630300

Daniel A. Rosenberg of Davis Brown Koehn Shors & Roberts,
P.C. for Titan International, Inc.

Irene Williams, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Chapman, Bucher and Holtzman, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Titan International, Inc. seeks registration on the
Principal Register of the mark MUD MONSTER for goods
identified in the application, as amended, as "tires, but
not tires for two-wheeled motor vehicles."¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to
register this mark based upon Section 2(d) of the Trademark
Act, 15 U.S.C. §1052(d). The Trademark Examining Attorney

¹ Application Serial No. 75630300 was filed on January 29,
1999 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce.

has held that applicant's mark, when used in connection with the identified goods, so resembles the mark MONSTER registered for goods identified as follows:

"motors (except for land vehicles)" in International Class 7;

"ships; boats, structural parts and fittings therefor; air cushion vehicles, aircraft, structural parts and fittings therefor; railway cars, structural parts and fittings therefor; motor vehicles, structural parts and fittings therefor; motorcycles, bicycles, structural parts and fittings therefor; two-wheeled motor vehicles, structural parts and fittings therefor, namely, chainwheels, cranks, air pumps, alarming horns, saddles, spindles, stands, spokes, tires, chains, chain cases, inner tubes, mudguards, grips, luggage carriers, hubs, handlebars, freewheels, frames, pedals, front forks, wheel rims, tires; wheelchairs; cable transport installations for cargo handling; non-electric motor and vehicle parts for land vehicles, namely, internal combustion engines, steam engines, jet engines; machine elements for land vehicles, namely, shafts, axles, spindles, journals, shaft couplings, bearings, power transmissions, shock absorbers, springs, brakes, alternating current motors, direct current motors, tire patches, anti-theft devices," in International Class 12; and

"leather jackets, pants, shirts, clothing belts, blouses, sweaters and scarves, all for motorcyclists," in International Class 25²

as to be likely to cause confusion, to cause mistake or to deceive.

² Registration No. 2454334 issued to Ducati Motor S.p.A. on May 29, 2001.

The Trademark Examining Attorney and applicant have fully briefed the case and both appeared at an oral hearing conducted by the Board.

The Trademark Examining Attorney argues that the involved marks are highly similar; that applicant's goods are closely related, if not identical, to registrant's goods; that they move through the same channels of trade; and that under the circumstances of this case, even sophisticated purchasers might well be confused.

Applicant responds that the overall impressions of these two marks are different; that applicant's goods are neither similar nor related to registrant's goods; and that these respective goods do not move through the same channels of trade.

We reverse the refusal to register.

Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing upon the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relationship of the

goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Accordingly, we turn first to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound and connotation.

In summarizing her comparison of the involved marks, the Trademark Examining Attorney argues that " ... the dominant portion of both registrant's and applicant's marks is MONSTER The addition of the term MUD to [registrant's mark for] tires merely specifies that these particular "monster" tires can be used in mud An applicant [*sic*, A potential customer] might well assume the tires the applicant has are specialized tires from the MONSTER house brand tires." (Trademark Examining Attorney's appeal brief, p. 3)

In response, applicant argues that the Trademark Examining Attorney has improperly dissected its mark - that the comparison must be between MUD MONSTER and MONSTER, compared in their entireties. Applicant argues that because the word MUD appears first in applicant's mark, it should be considered the dominant and most important portion of its mark. Moreover, applicant argues that the Trademark Examining Attorney has unfairly dismissed the

significance of the initial word of its mark, MUD, as nothing more than a descriptive term. Applicant argues that while the word "mud" may be suggestive of tires designed for off-road use, it is not a grade designation for tires. Furthermore, applicant argues that in addition to the obvious differences in sound and appearance between MUD MONSTER and MONSTER, the initial word, MUD, changes the connotation of its mark. For example, while MONSTER alone may connote a frightening creature, applicant argues that "the phrase MUD MONSTER associated with tires conjures an image of large tires that can tackle mud"

While the word "monster" is still an important component of applicant's mark, and shares with registrant's mark the idea of largeness, we also agree with applicant that when considered in their entirety, and when applied to the respective goods, the two terms create somewhat different overall commercial impressions.

We turn then to the relatedness of the goods as listed in the instant application and in the cited registration. Applicant intends to use its mark with "tires, but not tires for two-wheeled motor vehicles." This amended identification of goods was submitted during the course of the involved prosecution in order to overcome the Section

2(d) refusal to register by making it clear that applicant did not intend to use this mark on motorcycle tires.

However, the goods in the cited registration are clearly not limited to motorcycles and motorcycle parts. Of primary importance to this proceeding is registrant's long listing of items in International Class 12, which appears to combine two types of goods. In the first category, we note that the cited registration is based upon a foreign registration under Section 44 of the Trademark Act, and the long listing of goods in the vehicle class includes a series of disparate and broadly-stated goods (e.g., "steam engines," "ships," "boats," "air cushion vehicles," "jet engines," "aircraft," "railway cars," "cable transport installations for cargo handling," and "wheelchairs") having nothing to do with motorcycles. The second and larger grouping of goods in this class is prefaced by the phrase "two-wheeled motor vehicles, structural parts and fittings therefor." Some of the enumerated items that follow are, by definition, found only on two-wheeled motor vehicles (e.g., "saddles," "stands," "handlebars," "front forks," etc.). Other parts and accessories (like "mudguards") that could arguably be interpreted as being designed either for motorcycles or for

motor vehicles other than two-wheeled vehicles are listed after an explicit limitation to parts for "two-wheeled motor vehicles."³

Nonetheless, the Trademark Examining Attorney argues that the registrant's identification of goods might be "identical" to applicant's goods. In her brief, she argues as follows:

The applicant's "Tires, but not tires for two-wheeled motor vehicles" are similar and related to the registrant's "motor vehicles, structural parts and fittings therefor" and other parts specifically mentioned in the identification such as mud guards. The goods may even be identical, given the registrant's broad identification of goods. A potential customer is very likely to believe that vehicles and their parts emanate from the same single source. In re Jeep Corp., 222 USPQ 333 (1983) [contemporaneous use of "Laredo" for land vehicles and structural parts therefor, and for pneumatic tires, is likely to cause confusion.]

(Trademark Examining Attorney's appeal brief, p. 6).

However, as argued by applicant, registrant's "tires" and "mud guards" are enumerated only for "two-wheeled motor vehicles."

³ While the goods listed in International Class 25 of the cited registration do not figure prominently in the likelihood of confusion analysis herein, we note, in the context of registrant's prospective customers, that the clothing items are explicitly limited to "motorcyclists."

Of course, as pointed out by the Trademark Examining Attorney, registrant's long listing of goods in International Class 12 does include the phrase "motor vehicles, structural parts and fittings therefor." The Trademark Examining Attorney argues this might well include tires. However, there is no evidence that tires are considered to be "structural parts" for motor vehicles.

Thus, based upon our review of the cited registration, the closest relationship of the goods herein is between registrant's tires as well as related parts, fittings and accessories for two-wheeled motor vehicles, on the one hand, and applicant's tires for motor vehicles other than two-wheeled vehicles, on the other hand. However, the record does not shed any light on the commercial relationship, if any, between motorcycle tires and tires for motor vehicles other than two-wheeled vehicles. Nor has the Trademark Examining Attorney placed any evidence into the record demonstrating that the channels of trade for motorcycle tires and tires for larger land motor vehicles (other than two-wheeled vehicles) are ever overlapping.

Furthermore in addition to these differences in the goods, the marks herein are not the same, as noted earlier.

Hence, we find that the holding of In re Jeep Corp. is not applicable to the facts of this case.⁴

Accordingly, we find that the Trademark Examining Attorney has failed to make a *prima facie* showing that applicant's goods are related to registrant's goods.

Finally, as to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, we acknowledge applicant's point that vehicle tires directed to ordinary consumers are costly enough that they cannot be considered to be impulse purchases, the tires must be compatible with the tire specifications set by the vehicle manufacturer, and hence, replacement tires will be bought with greater care than would be the case with more inexpensive, routine purchases. Yet, applicant goes further in arguing that it makes special off-highway tires designed for large agricultural, construction, industrial and military vehicles - tires that are not only quite

⁴ The marks in Jeep Corp. were identical (e.g., LAREDO). Additionally, in Jeep Corp., the cited registered mark was for pneumatic tires while the application was for land vehicles and structural parts therefor. This is consistent with long-settled Board precedent finding likelihood of confusion when the same or quite similar marks have been used on different types of vehicular parts, or when the same or quite similar marks have been used on vehicles, on the one hand, and various vehicle parts or accessories for those vehicles, including tires, on the other. By contrast, here we are dealing with the difference between tires for two-wheeled motor vehicles and tires other than those for two-wheeled vehicles.

expensive but which are substantially all bought by sophisticated purchasers. While this is a compelling argument, the factual record does not support the more limited scope of these tires as argued by applicant, and the identification of goods is not restricted to these narrow channels of trade. Accordingly, the du Pont factor focusing on the conditions under which and buyers to whom sales are made must be considered to be a neutral factor in making our determination on likelihood of confusion herein.

In summary, we find on this *ex parte* record that the two terms create a somewhat different overall commercial impression, that the goods have not been shown to be related, and that there is no evidence as to the respective channels of trade or the sophistication of the purchasers. Thus, we find that a likelihood of confusion between these marks as applied to the respective goods of applicant and registrant has not been shown.

Decision: The refusal to register based upon Section 2(d) of the Trademark Act is hereby reversed.